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REMARKS

Claims 1-20 are currently pending in the subject application. Claims 1-11 are presently under consideration, and claims 12-20 are currently withdrawn.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1-7 Under 35 U.S.C. §102(b)**

Claims 1-7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Callaghan, *et al.* (US 6,058,304). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Callaghan, *et al.* does not teach or suggest each and every limitation of applicants' claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject invention relates to a portable electronic device that can be coupled to multiple additional devices and also containing an ASIC that can communicate with the coupled devices. In particular, independent claim 1 recites *an imager coupled to the portable electronic device and a laser scanner coupled to the portable electronic device*. These are two separate and distinct image based data capture devices coupled to the portable electronic device. The imager is an image capture device, such as a charged couple device (CCD) photosensor array imaging device. The laser scanner includes its own laser output and image sensor. Furthermore, the subject claim recites *an application specific integrated circuit (ASIC) comprising circuitry for communicating with the imager and laser scanner*. Refer to Figure 1 and to page 4, lines 19-23 of the specification which states "Fig. 1 is a high-level schematic illustration of a portable bar code reading terminal 5 employing an ASIC 10 having circuitry 12 for carrying N number of functions (N being an integer). The terminal is coupled to M number of devices 13 (M being an integer), such as *an imager, a laser scanner, a fingerprint reader, etc.*" Also refer to page 6, lines 4-9 of the specification which states "Furthermore, in conventional systems, two

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completely different sets of hardware and software were used to route *data from an imager* and *data from a scanner* to a system. According to an aspect of the present invention, the ASIC 10 *interfaces with both an imager and a scanner* and routes the *data from the two devices* to the bar code reading terminal 5." These sections of the specification and drawings clearly support the subject claim's recitation of two separate image based data capture devices, an imager and a laser scanner coupled to the terminal, each providing separate data captured from each device to the ASIC.

Contrary to the Examiner's assertions, Callaghan, *et al.* does not teach this aspect of the subject claim. Rather, the section of prior art referenced in the Office Action describes a *single* image capture device connected to the portable unit, a laser scanning assembly comprised of an infra-red light source and a light sensor. Callaghan, *et al.* fails to describe a secondary device being an imager connected to the portable unit. Callaghan, *et al.* does teach an optical interface that is employed to transmit output data to a printer or communicate with a base unit. However, this is not an image capture device comparable to the imager as taught in the applicants' claimed invention. The optical interface is strictly described as a wireless communication link and is not capable of capturing an image. An image capture device functions by transmitting light and producing an image from light reflecting back off of surfaces. A wireless optical communication interface relies on unobstructed line of sight light pulses being received from an optical transmitter located on a separate device. Furthermore, the prior art reference fails to disclose *an application specific integrated circuit (ASIC) comprising circuitry for communicating with the imager and laser scanner*. Callaghan, *et al.* discloses an ASIC that communicates with multiple devices such as a laser scanner, microphone, cellular telephony interface, and an optical interface. However, the cited reference fails to disclose that the ASIC contains circuitry for communicating with both an imager and a laser scanner.

In view of at least the above, it is respectfully submitted that Callaghan, *et al.* does not teach or suggest applicants' claimed invention as recited in independent claim 1 (and claims 2-7 which depend there from). Accordingly, withdrawal of this rejection is respectfully requested.

## II. Rejection of Claims 8 and 9 Under 35 U.S.C. §103(a)

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Callaghan, *et al.* in view of Kunert, *et al.* (US 6,109,528). It is respectfully submitted that this rejection should be

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reversed for at least the following reasons. Callaghan, *et al.* and Kunert, *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Kunert, *et al.* does not make up for the aforementioned deficiencies of Callaghan, *et al.* with respect to independent claim 1 (which claims 8 and 9 depend from). Rather, as discussed in the Appeal Brief, Kunert, *et al.* describes a portable data collection terminal that contains a single image capture device, a laser scanning assembly. Therefore, it is readily apparent that Callaghan, *et al.* individually or in combination with Kunert, *et al.* fails to teach or suggest *an imager coupled to the portable electronic device and a laser scanner coupled to the portable electronic device and an application specific integrated circuit (ASIC) comprising circuitry for communicating with the imager and laser scanner*. Accordingly, withdrawal of this rejection is respectfully requested.

### III. Rejection of Claims 10 and 11 Under 35 U.S.C. §103(a)

Claims 10 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Callaghan, *et al.* in view of Meier, *et al.* (US 6,561,428). It is respectfully submitted that this rejection should be reversed for at least the following reasons. Callaghan, *et al.* and Meier, *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicants' claimed invention. Meier, *et al.* does not make up for the above noted deficiencies of Callaghan, *et al.* with respect to independent claim 1 (which claims 10 and 11 indirectly depend from). Meier, *et al.* teaches a method to improve image capture as it relates to an indicia bearing substrate

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orientation with respect to the image capture device. The methods of Meier, *et al.* employ a single image capture device. Consequently, it is respectfully submitted that that Meier, *et al.* individually or in combination with Callaghan, *et al.* fails to teach or suggest *an imager coupled to the portable electronic device and a laser scanner coupled to the portable electronic device and an application specific integrated circuit (ASIC) comprising circuitry for communicating with the imager and laser scanner*. Therefore, withdrawal of this rejection is respectfully requested.

Conclusion

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP102US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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